IV. REMARKS

This is in response to the Office Action mailed 5/7/03 (Paper No. 5). The specification on page 26, line 1 through page 26, line 36 has been amended above to correct a typographical error. Claim 18 has been amended above to correct a typographical error. Claims 1 to 23 are pending in the application.

1. Claims 1, 3-7, 9-13, 16-20, and 23 have been rejected under 35 U.S.C. 103 as being unpatentable over Hashimoto et al. (hereinafter Hashimoto). The Applicants respectfully disagree.

The arguments contained within the applicants' amendment filed 2/19/03 are incorporated herein by reference.

As noted before, claim 23 recites that the controller is programmed that if the size of the image is larger than the predetermined image size the controller makes available for selection user selectable features (including image cropping or image reduction). Clearly, Hashimoto does not disclose or suggest this. Although, Hashimoto discloses user selectable masking, trimming, erasing, and image shifting functions (col. 8, lines 26-29, and col. 9, lines 1-4) these features are "always on". The Examiner agrees with this on page 3 of the Action. Further the Examiner states that having these user selectable features always on means that the features are always present for user selection. Correspondingly, if the user selectable features are always present, then it axiomatically follows that they cannot be made present or made available upon the occurrence of some event (i.e. if the size of the image is larger than the predetermined size). If something is always present or available, then it cannot possibly be made present or available as it is already there. Hashimoto does not mention making features available for user selection if the size of the

image on the medium is larger than a predetermined image size as otherwise called for in claim 23. Hashimoto clearly does not disclose or suggest making available for selection user selectable features including cropping the image, or reducing the image if the size of the image is larger than the predetermined image size as called for in Claim 23.

It would not have been obvious to one skilled in the art from the disclosure in Hashimoto without more to modify the Hashimoto copier to make available the user selectable features of cropping the image, or reducing the image if the size of the image on the medium to be copied is larger than a predetermined size as called for in Claim 23. Claim 23 is patentable over the cited prior art and should be allowed.

Claim 1 recites that in response to registering with the controller that the image on the medium (i.e. the original image being read by the reader) is larger than a predetermined size, then forming with the controller a modified image from the image on the medium. Applicants would like to particularly point out to the examiner that according to claim 1 what is being registered by the controller is

a) that the size of the image on the medium is larger than some predetermined size; (This is not the same as registering the image or the size of the image.); and

b) That it is the size of the image on the medium that is being addressed.

These features are not disclosed or suggested in Hashimoto.

In Figure 2, Hashimoto discloses a copier with an electro-optical scanner 15 for scanning documents and a printing

section, including a writing laser, for printing images on paper. The copying process is controlled by CPU 130 which has an image control circuit 132 that generates various kinds of timing signals to the writing laser in order to allow for various editing functions to be performed. These editing functions include masking, trimming, erasing, image shift (see Col. 8, lines 26-29, and Col. 9, lines 1-4), which are selected by the user from function keys on the copier display 239. The CPU 130 in performing these functions does not register that the size of the image on the medium being copied is larger than a predetermined size. To the contrary, the image control circuit 132 merely varies the timing of the writing laser in order to effect the selected function. (i.e. If cropping is desired, then in effect, the CPU merely identifies and tags the data portion of the recorded image (e.g. bitmap) corresponding to the portion being cropped and stops the laser when the printing out to the laser reaches this data.) This does not mean that the CPU 130 registers that the size of the image on the medium is larger than a predetermined size. The CPU in Hashimoto need not register that the image on the medium (in contrast to the recorded image) is larger than a predetermined size in order to effect any of the user selectable functions. Hence, the user selected editing functions in Hashimoto clearly do not disclose or suggest registering with the controller that the image on the medium is larger than a predetermined size as called for in Claim 1.

In Col. 10, lines 27-30, Hashimoto discloses that the standard picture display has a sheet-priority magnification change key 268 for effecting the automatic enlargement or reduction of image data in conformity to sheet size selected. Hashimoto fails to disclose how automatic enlargement or reduction of

image data in conformity to sheet size is accomplished. There is no mention whatsoever of registering with the controller that the image on the medium is larger than a predetermined size. However, the automatic enlargement/reduction of image data in conformity to sheet size may be accomplished without having to register whether the image on the medium itself is larger than a predetermined size. For example, CPU 130 may control the timing signals for the image data to the writing laser so that the image "written" by the laser along a given scan line falls within the boundaries for the print sheet size. If the CPU 130 detects that some amount of image data along one or more scan lines "extends" beyond the length or width boundaries of the selected print sheet using standard timing signals, the CPU 130 may adjust the timing signals to the writing laser, such that the image data is reduced to fit the given boundaries. This is very different than registering that the image on the medium is itself larger than a predetermined size. Clearly, this method for detecting image data to the writing laser that will exceed the sheet boundaries does not involve registering that the image on the medium (not the recorded data) is larger than a predetermined size. Hence, the automatic enlargement/reduction to selected sheet size functions in Hashimoto clearly do not disclose or suggest registering with the controller that the image on the medium is larger than a predetermined size as called for in Claim 1.

It would not have been obvious to one skilled in the art from the disclosure in Hashimoto without more to modify the Hashimoto copier to register with the controller whether the image on the medium is larger than a predetermined size as called for in Claim 1. Claim 1 is patentable over the cited prior art and should be allowed. Claims 2-8 depend from claim 1 and should

also be allowed. Claims 9, and 16 include features similar to Claim 1 and are allowable for the above-noted reasons. Claims 10-15 and claims 17-22 depend from claims 9 and 16 respectively, and should also be allowed.

2. Claims 2, 14, and 22 have been rejected under 35 U.S.C. 103 as being unpatentable over Hashimoto ('319) in view of Barrett et al.(U.S. Patent No. 5,301,036 and hereinafter Barrett). The Applicants respectfully disagree.

To establish a prima facie case of obviousness the cited combination of prior art references must teach or suggest all the claim features. Although Barrett discloses a controller having the capability of rotating an image in at least 90° increments, the combination with Hashimoto does not teach all elements of the applicants' invention in Claims 2, 14, and 22. In particular, for the reasons cited above, Hashimoto in view of Barrett does not determine or register with the controller that the image on the medium to be rotated is larger than a predetermined size.

Claims 2, 14 and 22 are patentable over the cited prior art and should be allowed.

3. Claims 8, 15, and 21 have been rejected under 35 U.S.C. 103 as being unpatentable over Hashimoto ('319) in view of Salgado et al.(U.S. Patent No. 5,946,527 and hereinafter Salgado). The Applicants respectfully disagree.

Although Salgado discloses a controller having the capability of displaying a warning message, the combination with Hashimoto

does not teach all elements of the applicants' invention in Claims 8, 15, and 21. In particular, for the reasons cited above, Hashimoto in view of Salgado does not determine or register with the controller that the image on the medium is larger than a predetermined size to be displayed via a warning message.

Claims 8, 15, and 21 are patentable over the cited prior art and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

Respectfully submitted,

7/16/03

Janik Marcovici
Reg. No. 42,841

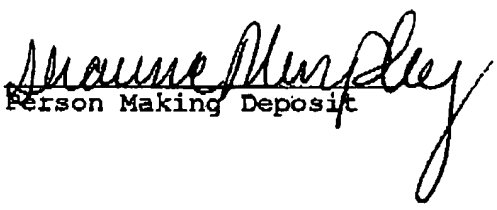
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to Jason Sherrill the date indicated below, addressed to the Box AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: 7/16/03

Signature: 
Person Making Deposit